

Appl. No. 10/532,933
Response to Office Action of April 26, 2006

PATENT
Docket No.: NL021065
Customer No. 000024737

REMARKS

By this amendment, claims 7 and 10 have been canceled. Claims 1-6, 8, 9 and 11-13 have been amended. Claims 1-6, 8, 9 and 11-13 remain in the application. Support for the amendments to the claims can be found the specification and drawings, including, for example on page 3, lines 17-19; page 6, lines 15-17, 23-26 and 31-33; and page 7, lines 6-8. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, and allowance of the application, as amended, is respectfully requested.

Objection to the Specification

The specification was objected to by the Examiner. The Office Action notes that the application does not contain an abstract. While a review of the image file wrapper on the USPTO website in the instant application shows an abstract dated 2005-04-27, Applicant has repeated the abstract herein. Accordingly, objection to the specification is now believed overcome. Withdrawal of the objection to the specification is requested.

Objections to the Claims

Claims 4 and 12 were objected to because of informalities. The claims have been amended herein to provide appropriate corrections. Accordingly, the objection to the claims is now believed overcome.

Rejection under 35 U.S.C. §102

Claim 1 recites a coordinate measuring device having a probe comprising: a stylus (14) with a sensing member (18) for contacting an object (15) to be measured; elastic means (19) including two spaced-apart spring members (52), each spring member having a central portion, a circumferential ring portion, and at least one leaf spring (41) extending between the central portion and the circumferential ring portion, wherein each spring member further comprises conductive material; a support unit (13)

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PATENT
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to which the stylus (14) is connected through said elastic means (19), wherein a flexibility of the at least one leaf spring of each spring member provides an elastic connection between the support unit and the stylus; and magnet means (46) incorporated within a plate of nonmagnetic material and appearing on surfaces at both sides of the plate of nonmagnetic material, wherein the plate of nonmagnetic material has a circular shape of a same diameter as each of the spring members and has a hole in a central part thereof for passage of the stylus (14) there-through, said plate further having a circumferential ring shaped thick portion that comprises a thickness greater than a thickness of a remainder portion of the plate, wherein the circumferential ring shaped thick portion provides a predetermined distance between each of the two spring members and the plate, wherein the plate is located between the two spaced-apart spring members (52), and wherein said magnet means (46) are further for damping vibrations of the stylus (14) by generating eddy currents in the conductive material of each leaf spring of said elastic means.

Claims 1, 4, 6, 9 and 11-13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Aehnelt et al (US 5,111,592). With respect to claim 1, Applicant respectfully traverses this rejection for at least the following reasons.

The PTO provides in MPEP § 2131 that
"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, with respect to claim 1, to sustain this rejection the Aehnelt reference must contain all of the above claimed elements of the respective claims. However, contrary to the examiner's position that all elements are disclosed in the Aehnelt reference, the latter reference does not disclose elastic means including two spaced-apart spring members, each spring member having a central portion, a circumferential ring portion, and at least one leaf spring extending between the central portion and the circumferential ring portion. Neither does the Aehnelt reference disclose magnet means

Appl. No. 10/532,933
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PATENT
Docket No.: NL021065
Customer No. 000024737

incorporated within a plate of nonmagnetic material and appearing on surfaces at both sides of the plate of nonmagnetic material, wherein the plate of nonmagnetic material has a circular shape of a same diameter as each of the spring members and has a hole in a central part thereof for passage of the stylus there-through, said plate further having a circumferential ring shaped thick portion that comprises a thickness greater than a thickness of a remainder portion of the plate, wherein the circumferential ring shaped thick portion provides a predetermined distance between each of the two spring members and the plate, wherein the plate is located between the two spaced-apart spring members.

In contrast, Aehnelt discloses a flexible coupling that consists of a stacked plurality of interconnected flat disks or rings of spring material, one ring on top of the next (Aehnelt at column 2, lines 38-40). In addition, as found in column 3, lines 2-4 of Aehnelt, the probe-pin carrier is "urged against the fixed part [i.e., annular collar 11] of the probe head by means of a spring or by magnetic forces." [Emphasis added] Furthermore, as can be understood from the embodiments of Aehnelt, "[i]t is particularly advantageous for the moving part (i.e., the probe-pin carrier) to be urged against the fixed housing part not only by axial spring force that is inherent in elasticity of the spring rings of the coupling, but also use of magnetic forces." [Emphasis added] (Aehnelt at column 3, lines 28-35). Therefore, the rejection is not supported by the Aehnelt reference and should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Dependent claims 4, 6, 9 and 11-12 depend from and further limit independent claim 1 and therefore are allowable as well. Claim 13 contains limitations similar to those of claim 1, and is believed allowable over Aehnelt for similar reasons as stated herein with respect to claim 1. Accordingly, the 35 U.S.C. § 102(b) rejection thereof has now been overcome.

Rejection under 35 U.S.C. §103

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over

Appl. No. 10/532,933
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PATENT
Docket No.: NL021065
Customer No. 000024737

Aehnelt et al. in view of Abiru et al (US 4,187,614). With respect to claim 5, applicant respectfully traverses this rejection for at least the following reasons. Dependent claim 5 depends from and further limits independent allowable claim 1 and therefore is allowable as well. Accordingly, the 35 U.S.C. § 103(a) rejection thereof has now been overcome.

Claims 1-3, 7, 9, 10 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Edenharter et al. (DE 362636 A) in view of Linke (US 4,688,326). With respect to claims 7 and 10, the same have been cancelled herein, thus rendering the rejection thereof moot. With respect to claim 1, applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 1.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the at least the following reasons.

Even When Combined, the References Do Not Teach the Claimed Subject Matter

The Edenharter and Linke patents cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ...
(Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither Edenharter nor Linke teaches (i)

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PATENT
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elastic means including two spaced-apart spring members, each spring member having a central portion, a circumferential ring portion, and at least one leaf spring extending between the central portion and the circumferential ring portion and (ii) magnet means incorporated within a plate of nonmagnetic material and appearing on surfaces at both sides of the plate of nonmagnetic material, wherein the plate of nonmagnetic material has a circular shape of a same diameter as each of the spring members and has a hole in a central part thereof for passage of the stylus there-through, said plate further having a circumferential ring shaped thick portion that comprises a thickness greater than a thickness of a remainder portion of the plate, wherein the circumferential ring shaped thick portion provides a predetermined distance between each of the two spring members and the plate, wherein the plate is located between the two spaced-apart spring members as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Dependent claims 2-3 and 9 depend from and further limit independent claim 1 and therefore are allowable as well. Claim 13 contains limitations similar to those of claim 1, and is believed allowable over Edenharter in view of Linke for similar reasons as stated herein with respect to claim 1. Accordingly, the 35 U.S.C. § 103(a) rejection thereof has now been overcome.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Edenharter et al. and Linke as applied to claims 1-3, 7, 9, 10 and 13 above, and further in view of Abiru et al. With respect to claim 8, applicant respectfully traverses this rejection for at least the following reasons. Dependent claim 8 depends from and further limits independent allowable claim 1 and therefore is allowable as well. Accordingly, the 35 U.S.C. § 103(a) rejection thereof has now been overcome.

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Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1 and 13 are in condition for allowance. Dependent claims 2-6, 8, 9 and 11-12 depend from and further limit independent claim 1, and therefore are allowable as well. The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1-6, 8, 9 and 11-13 is requested.

Respectfully submitted,

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Dated: 7/25/06

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a-32658.101

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7/25/06